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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/656,699 | 09/04/2003 | Loren R. Graber | 20794-82667 | 8589 |
| 7590 08/11/2006 | | | EXAMINER | |
| Barnes & Thornburg 600 One Summit Square Fort Wayne, IN 46802 | | | SPAHN, GAY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3673 | |
| DATE MAILED: 08/11/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/656,699

Applicant(s)

LOREN R. GRABER

Examiner

Gay Ann Spahn

Art Unit

3673

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.


AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants are requesting withdrawal of finality based on their allegation that the rejection of claims 8-13 and 15-19 under 35 USC 102(b) as being anticipated by SINANAN (U.S. Patent No. 5,852,895) as evidenced by TER HORST (European Patent Publication No. EP 0 276 515 A1) constitutes a new ground of rejection that was neither necessitated by amendment, nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 CFR 1.97(c). Applicants state that SPE Patricia Engle's explanation that finality of the Office Action is proper because amended claim 1 was more than original claim 2 simply rewritten in independent form is irrelevant because "[t]he Examiner's reason for citing Ter Horst was to provide support for the Examiner's rejection of the claimed 'removable portions' and 'selectively removable portion.' Applicants' argument is misplaced because it is entirely relevant that claim 1 was amended to be more than originally filed claim 2 simply rewritten in independent form. Applicants list claims that they consider to be either unamended or 'nominally' amended as evidence that the examiner's rejection in the Office Action mailed 28 June 2006 was not necessitated by amendment and alleges that "[i]t is wholly improper to finally reject originally filed claims, or even nominally amended claims for that matter, using a newly cited reference". The examiner agrees with Applicants' allegation. However, Applicants seem to fail to realize that amending independent claims 1 and 8 also amends all of the claims dependent thereon in the same manner (i.e., claims 9, 12, 13, and 17 are NOT original claims as alleged by Applicants and claims 10, 11, 15, 16, 18, and 19 were not just nominally amended claims as alleged by Applicants because all these claims were amended by the amendments made to independent claim 8). The examiner notices that Applicants are NOT arguing that the finality of the rejection of claim 8 was improper because they realize that claim 8 is not simply claim 14 rewritten in independent form and thus is not an original claim, but is an amended claim. Thus, even if the rejection of claims 8-13 and 15-19 under 35 USC 102(b) as being anticipated by SINANAN as evidenced by TER HORST were a new rejection, which the examiner is NOT conceding that it is, it would not matter because that new rejection would have been necessitated by Applicants amendment of independent claim 8. Applicants allege that TER HORST was only cited to provide support for 'removable portions' or 'selectively removable portion'. This is not correct. TER HORST was cited to provide evidence that it is inherent that SINANAN has 'selectively removable portions'. The TER HORST reference has not been combined with SINANAN, only simply provided as evidence similar to as is done in the case of Official Notice. The examiner points out by way of analogy that when Official Notice is used in an Office Action, an Applicant may request that the examiner provide evidence of the thing for which Official Notice was taken and in this case, the examiner may cite a reference as evidence of the thing Officially Noticed and still make the rejection final because the reference is not being combined with the references used in the rejection, it is simply being offered as evidence of the thing being Officially Noticed. In the same manner, the examiner did not combine TER HORST with SINANAN, the examiner simply offered TER HORST as evidence that SINANAN inherently has a 'selectively removable portion'. Applicants' allegation that "[t]his application was pulled from appeal precisely because the prior cited art and arguments failed to anticipate or make obvious these originally presented or nominally amended claims" and that "[t]he withdrawal of the appeal by the USPTO is prima facie evidence that Ter Horst is required to demonstrate either anticipation or obviousness" is without merit. The application was not ready for appeal because although the examiner had cited the best prior art, she had misapplied the REUM ET AL. reference by citing the Fig. 1 and 14 embodiments, when she clearly meant to cite the Figs. 19-21 embodiment. Thus, finality was withdrawn and a new Office Action was done simply to replace the properly made FINAL ACTION mailed on 24 October 2005. Applicant is not arguing that the FINAL ACTION mailed on 24 October 2005 was improperly made final. If it was proper to make the Office Action mailed on 24 October 2005 final, then it is still proper to make the 28 June 2006 Office Action final because both actions are in response to the same amendment. Finally, Applicants allege that "citing Ter Horst against claims as originally filed, as well as only nominally amended claims, introduces a new round of rejection that was neither necessitated by Applicants' amendment of the claims, nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 CFR 1.97(c)". This allegation is entirely incorrect because as explained above, there were no originally filed or nominally amended claims because the same amendments made to independent claims 1 and 8 were made to the claims dependent thereon. Thus, the finality of the Office Action mailed 28 June 2006 is proper and is being maintained.


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8-7-2006